

Attorney Docket No.: ISPH-0567  
Inventors: Bennett et al.  
Serial No.: 09/938,048  
Filing Date: August 23, 2001  
Page 6

#### REMARKS

Claims 1, 2, 4-8, 10 and 11 are pending in the instant application. Claims 1, 2, 4-8, 10 and 11 have been rejected. Claim 1 has been amended. No new matter has been added by this amendment. Reconsideration is respectfully requested in light of the following remarks.

#### I. Rejection of Claims Under 35 U.S.C. §102

The rejection of claims 1, 2, 4-8, 10 and 11 under 35 U.S.C. §102(b), as being anticipated by Baker et al. (U.S. Patent 6,080,580) has been maintained. The Examiner suggests that this patent discloses use of an antisense library targeted to TNF- $\alpha$ , a cytokine, which is involved in inflammatory responses, including adding these antisense oligonucleotides to cells and measuring expression of the TNF- $\alpha$  gene following such treatment.

The rejection of claims 1, 2, 4-8, 10 and 11 under 35 U.S.C. §102(b), as being anticipated by Bennett et al. (U.S. Patent 5,514,788) has been maintained. The Examiner suggests that this patent discloses use of antisense targeted to various cell adhesion molecules that are involved in inflammation, specifically ICAM, VCAM and ELAM. The Examiner suggests that this patent discloses inhibition of these adhesion proteins with antisense oligonucleotides from antisense libraries as well as measurement of levels of gene expression in cells after treatment of the cells with antisense and prior to challenge of the cells with various cytokines.

Applicants respectfully traverse these rejections.

In an effort to advance the prosecution of this application, Applicants have amended claim 1 to recite the additional step of

Attorney Docket No.: ISPH-0567  
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Serial No.: 09/938,048  
Filing Date: August 23, 2001  
Page 7

identifying the antisense oligonucleotides which have been determined to modulate the inflammatory response. As these identified antisense oligonucleotides specifically hybridize to a gene encoding a cytokine or growth factor, the identity of the corresponding genes involved in an inflammatory response to an inflammatory stimulus can be determined. Support for this amendment can be found at page 9, lines 9-15 of the specification. As discussed in the previous Office Action responses, neither Baker et al. (U.S. Patent 6,080,580) nor Bennett et al. (U.S. Patent 5,514,788) disclose a method for identifying a gene involved in a response such as claimed in the instant invention. The present method specifies contacting cells, tissues or organisms that are capable of exhibiting an inflammatory response, after a stimulus has been applied, with a library of antisense oligonucleotides prior to treatment with a stimulus, determining which antisense oligonucleotides modulate the inflammatory response, identifying said antisense oligonucleotides, and using the identity of the antisense oligonucleotides to identify the corresponding genes involved in inflammation. Nowhere does the patents of Baker et al. and Bennett et al. teach a method where the goal is to identify a gene. In these patents, the gene is used to design oligonucleotides, the oligonucleotides are not used to identify a gene. Accordingly, these patents teach different methods from the method of the instant invention, failing to teach the limitations of the claims as now amended, and cannot anticipate the claimed invention. Withdrawal of these rejections is therefore respectfully requested.

Attorney Docket No.: ISPH-0567  
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Serial No.: 09/938,048  
Filing Date: August 23, 2001  
Page 8

## II. Conclusion

The Applicants believe that the foregoing comprises a full and complete response to the Advisory Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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